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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/734,566  | 12/12/2003  | Reinhard Lihl        | LVIP:108US          | 1877             |
| 7590  | 05/24/2006  |                      | EXAMINER            |                  |
| Robert P. Simpson, Esq.<br>Simpson & Simpson, PLLC<br>5555 Main Street<br>Williamsville, NY 14221 |             |                      | PETERSON, KENNETH E |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3724                |                  |

DATE MAILED: 05/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 10/734,566             | LIHL ET AL.         |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | Kenneth E. Peterson    | 3724                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 26 April 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 2-7 and 9-15 is/are pending in the application.
  - 4a) Of the above claim(s) 10-15 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 2-7 and 9-15 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____.  | 6) <input type="checkbox"/> Other: _____.                                   |

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1. Applicant's appeal brief, received 26 April 06, has been considered. An appeal brief conference was held, during which Supervisors Boyer Ashley and Peter Vo agreed that the rejection was good and could be forwarded to the Board of Appeals. However, there is always room to do better, so Examiner hereby re-opens prosecution with an even more comprehensive rejection. Authorization for this re-opening was granted by Supervisor Boyer Ashley.

2. Claims 2-7 are objected to because the titles are incorrect. The titles should be changed to correlate to parent claim 9.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-7 and 9 are rejected under 35 U.S.C. 103(a).

The patent to Niesporek et al.'654 shows a microtome having most of the recited limitations including a sensing device (20,44) controlling a feeder device (50) at different speeds (coarse speed, slicing speed).

Niesporak determines the position of the sample relative to the blade via a contact sensor (20) rather than a light barrier sensor.

Examiner notes that contact sensors and light barrier sensors are both very old and well known and also are art recognized equivalents. When sensing the position of

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a workpiece or tool part, one of ordinary skill would know that he has a choice between a contact sensor and a light barrier sensor. Evidence of this can be seen in numerous patents. See, for example, Guttler '970 (lines 23,24, column 6), Hannen et al.'719 (lines 51,52, column 3), Markgraf et al.'848 (lines 29-31, column 8), Naab '392 (lines 15-17, column 10), Kramer et al.'763 (lines 53,54, column 4) and Weinheimer '135 (lines 64,65, column 7). It would have been obvious to one of ordinary skill in the art to have modified Niesporak by making his contact sensor be a light barrier, since these are art recognized equivalents as set forth above, and also since light sensors (having no moving parts) are less likely to break.

If there is any doubt about the efficacy of light barrier sensors within microtomes, Examiner notes that light barrier sensors have long been employed for various purposes with microtomes. Evidence of this can be seen in numerous patents. See, for example, Walter et al.'653 (line 45, column 5), Pfeifer '657 (lines 39,40, column 3) and Sitte '234 (lines 1-6, column 6).

Also of interest, and making the modification even more obvious, is a patent to Mohr '886, who shows in figure 6 the use of light barrier to preposition the knife (7) relative to the workpiece (19) prior to initiation of the cutting cycle.

With regards to claim 2, determining a location for the sensor is within the capabilities of one of ordinary skill. In order to fulfill the function of Niesporak's sensor, one of ordinary skill could find numerous places to place the light sensor, including at the height of the knife. See In re Japikse, 86 USPQ 70 for a discussion on the obviousness of shifting parts locations.

With regards to claims 3,5 and 6, Niesporak's sensor is stationary and coupled to the knife holder.

With regards to claim 4, any light barrier emits electromagnetic radiation.

Applicant's range-within-a-range limitations of a laser or LED is not considered to further limit the claims. If Applicant would like Examiner to give weight to the laser or LED, Applicant should change the claim the laser or LED outside of a range-within-a-range. Nevertheless, Examiner takes Official Notice that it is well known to employ lasers or LEDs in light barriers, and It would have been obvious to one of ordinary skill in the art to have used a laser or LED in Niesporak's light barrier.

With regards to claim 7, Niesporak drives the specimen at different speeds (lines 51-54, column 4).

5. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ken Peterson whose telephone number is 571-272-4512. The examiner can normally be reached Mon-Thurs, 7:30AM-5PM

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KP  
May 19, 2006



KENNETH E. PETERSON  
PRIMARY EXAMINER